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10/731,203

12/10/2003

Jimmie R. Kilby

4600

7590

04/25/2006

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,203

Applicant(s)

KILBY, JIMMIE R.

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

WILLIAM M. PIERCE
PRIMARY EXAMINER

DETAILED ACTION***Claim Rejections - 35 USC § 101***

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Within the statutory classes is recognized an apparatus comprising a new and nonobvious combination of elements and a process comprising a combination of physical steps. Claims 1-3 appear to be drawn to neither class. Claim 1 is not directed to an apparatus in that it merely calls for a random number generator with no further combination of elements. To the extent that the claims may be a process claim, there exist no physical steps and merely recite the abstract idea that generating bingo numbers "so that the plurality of players realize a plurality of diminishing returns". Positive physical steps in a process claim would be for example generating a bingo number and recalculating and reducing the awards.

Claim Rejections - 35 USC § 112

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, one cannot determine if the scope of the claim invokes 112, sixth paragraph means plus function language. Applicant has not explicitly used the word "means" such that the scope of the claim and how it is to be interpreted can be determined.

Claim Objections

Claim 3 7-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 3 fails to further limit the structure of the previously claimed apparatus. How the game is played by "wherein the operator" fails to further limit the structure of the apparatus. Claims 7-17 recite the method of play for the operator what is needed to obtain an award which fails to further limit the structure of the previously claimed apparatus of claim 4. Claim 8 relates to how the game is played and fails to further limit the structure of the previously claimed apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15, 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank 6,186,892.

As to claims 1 and 18, Frank shows a game apparatus having a random number generator in fig. 4 and at (col. 6, ln. 64- col. 7, ln. 30). Since the claim does not appear to and is not being interpreted as invoking a 112, 6th paragraph means plus function limitation since it lacks an explicit use of the word “means”, the function and intended use limitations fail to distinguish over the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Where claims 4 and 5 recite “means”, the functional limitations of the generator selecting bingo cards and patterns is shown at col. 3, lns. 25-30 and the “diminishing awards” is shown at col. 4, lns 10-15 where Frank explicitly discloses that as “bingo numbers selected increases, the prize amounts decrease”. This results in a “controllable disadvantage to the operator” where “the operator’s overall percentage of retention is constant and is openly disclosed” (col 4. ln. 13). As to claims 2, 3, 6, a plurality of payout tables for a particular game format is shown at fig. 3. Depending upon the operator’s retention and the version of the game a different payout table is assigned by the operator. Claims 7-17 fail to distinguish over the apparatus of the prior art since in an apparatus claim (such as instant claim 4) such must be done by reciting structure and not how the game is played. Frank is capable performing the functions recited in the above claims.

As to claims 19, 23 and 24 the random number generator is show in a game machine to be capable of generating a plurality of bingo cards (col. 3, lns. 25-29) where a player is permitted to preselect a player pattern (abstract, ln. 3)). The random number generator is further capable of generating all 75 possible numbers as set forth at col. 3, lns. 63-68. Frank draws from every bingo number of the bingo game to match a player pattern which is considered to meet the limitations of the claim. As to claims 2, 6 and 19, Fig. 3 shows a paytable for a particular one of a plurality of formats (col. 5, ln. 48). He states that all such payout information is available to the players (col. 4, lns. 15-18). As to claims 3, 7 and 20, Frank shows the use of different paytables depending upon the type of game (col. 5, lns. 38-43). As to claims 8 and 21 wagers are shon (col. 4, ln. 10). Futher with respect to claims 8 and 9 a player selects his own bingo card to his satisfaction (col. 3, lns. 25-30). As to claims 10 and 22 a player may make additional wages on each card to achieve more than one award (col. 4 ln. 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank in view of Loyd 4,332,389.

The speed or pace at which a game is played, i.e. the rate at which numbers are drawn, is not considered to be a patentable advance. Loyd teaches that it would have been obvious to have the rate of balls called be determinable by the game operator.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Luciano, Schwartz, Wood, Cummings and Matsumoto show lot type games.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WILLIAM M. PIERCE
PRIMARY EXAMINER